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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/074,496	05/07/1998	JAMES R. ALBRITTON	091078.0554	2329

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BAKER AND BOTTS
2001 ROSS AVENUE
DALLAS, TX 752012980

EXAMINER

FERGUSON, MICHAEL P

ART UNIT	PAPER NUMBER
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3679

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/074,496	Applicant(s) ALBRITTON, JAMES R.	
	Examiner MICHAEL P. FERGUSON	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/07/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because of the following informalities:

The changes to Figures 7, 8 and 9 in the marked-up copy of the drawing corrections filed March 29, 2001 have been approved. However, formal replacement drawings showing the drawing corrections are required.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 37 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 37 (lines 8-12) recites "said first fastener having a first failure strength less than a second failure strength of said attachment; said first fastener having a first connector having a first failure strength and a second connector having a second failure strength; and said first failure strength greater than said second failure strength". It is

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unclear as to which of the recited first failure strengths is greater than which of the recited second failure strengths; the first failure strength of the first fastener or of the first connector, the second failure strength of the attachment or of the second fastener.

Claim 40 (lines 8-12) recites “said first fastener having a first failure strength less than a second failure strength of said second fastener; said first fastener having a first connector having a first failure strength and a second connector having a second failure strength; and said first failure strength greater than said second failure strength”. It is unclear as to which of the recited first failure strengths is greater than which of the recited second failure strengths; the first failure strength of the first fastener or of the first connector, the second failure strength of the second fastener or of the second connector.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 37 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilcox (US 4,183,695).

As to claim 37, Wilcox discloses a breakaway guardrail post capable of use with highway crash control systems comprising:

an upper post member **24,26** having a weak impact axis and a strong impact axis;

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a lower post member **12** disposed beneath and spaced apart from the upper post member;

a connecting joint member **30,32** having a first end and a second end, the first end of the joint member connected at the first end by a first fastener **40,42** to the upper post member and connected at the second end by an attachment to the lower post member (joint member **30,32** is connected by a welded attachment to lower post member **12**; column 1 lines 62-65), the first fastener having a first failure strength less than a second failure strength of the attachment;

the first fastener having a first connector **40** having a first failure strength and a second connector **42** having a second failure strength; and

the first failure strength greater than the second failure strength such that upon an impact force being applied along the weak impact axis, the second connector fails and the upper post member rotates about the first connector (Figures 1-6).

As to claim 40, Wilcox discloses a breakaway guardrail post capable of use with highway crash control systems comprising:

an upper post member **24,26** having a weak impact axis and a strong impact axis;

a lower post member **12** disposed beneath and spaced apart from the upper post member;

a connecting joint member **30,32** having a first end and a second end, the first end of the joint member connected at the first end by a first fastener **40,42** to the upper post member and connected at the second end by a second fastener to the lower post

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member (Joint member **30,32** is connected by a weld to lower post member **12**; column 1 lines 62-65. Such weld constitutes a fastener as is consistent with the Board of Patent Appeals and Interferences' interpretation of the term "fastener" within the BPAI decision dated March 23, 2007.), the first fastener having a first failure strength less than a second failure strength of the second fastener;

the first fastener having a first connector **40** having a first failure strength and a second connector **42** having a second failure strength; and

the first failure strength greater than the second failure strength such that upon an impact force being applied along the weak impact axis, the second connector fails and the upper post member rotates about the first connector (Figures 1-6).

Response to Arguments

6. Applicant's arguments, filed February 13, 2008, with respect to the rejection(s) of claim(s) 37 and 40 as being untimely under 35 USC 135(b)(1) have been fully considered and are persuasive. Accordingly, the rejection under 35 USC 135(b)(1) from the previous examiner has been withdrawn as claims 37 and 40. However, upon further consideration, a new ground(s) of rejection is made under 35 USC 102 in view of Wilcox (US 4,183,695). Note that this anticipatory rejection is consistent with the Board's decision that a weld constitutes a fastener. Further, also consistent with the Board's decision, note that the pivot pin and shear pin of Wilcox constitutes the first fastener and that this first fastener fails once the shear pin fails as failure of the first fastener does not require failure of the pivot pin (see page 4 of the Board decision of March 23, 2007).

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Claims 37 and 40 as currently presented "read on" the prior art device of Wilcox and thus remain not patentable to applicant.

Conclusion

The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure. The following patents show the state of the art with respect to breakaway guardrail posts:

McFarlin (US 79,141), Payne (US 413,088), Davis (US 446,852), Height (US 2,101,176) and Sweeney et al. (US 4,126,403) are cited for pertaining to posts comprising a connecting joint member connected to an upper post member by a first pivot connector and a second frangible connector.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL P. FERGUSON whose telephone number is (571)272-7081. The examiner can normally be reached on M-F (6:30am-3:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571)272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MPF
03/05/09

/Michael P. Ferguson/
Primary Examiner, Art Unit 3679

/Frederick R. Schmidt/
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